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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,221	01/21/2004	Kia Silverbrook	SMA06US	1369

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393 DARLING STREET
BALMAIN, NSW 2041
AUSTRALIA

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760.221

Applicant(s)

SILVERBROOK ET AL.

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-2 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claims 1-2 and 16 of the present application.

3. Claim 3 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 3 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 3 of the present application.

4. Claim 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 4 of the present application.

5. Claim 5 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 5 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 5 of the present application.

6. Claim 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 7 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 6 of the present application.

7. Claim 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 8 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 7 of the present application.

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8. Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 8 of the present application.

9. Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 10 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 9 of the present application.

10. Claims 10-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 11 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claims 10-11 of the present application.

11. Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 12 of the present application.

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12. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 13 of the present application.

13. Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 14 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 14 of the present application.

14. Claim 18 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 18 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 18 of the present application.

15. Claim 19 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 19 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 19 of the present application.

16. Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 20 of U.S. Patent No. 7,002,664. Although the conflicting claims

are not identical, they are not patentably distinct from each other because claim 20 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 20 of the present application.

17. Claim 21 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 21 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 21 of the present application.

18. Claim 22 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 22 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 22 of the present application.

19. Claim 23 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 23 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 23 of the present application.

20. Claim 24 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 7,002,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 24 of U.S. Patent No. 7,002,664 recites all the structure that is recited in claim 24 of the present application.

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21. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/760,229.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 15 of Application No. 10/760,229 recites all the structure of claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

22. Claim 17 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of copending Application No. 10/760,229.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 16 of Application No. 10/760,229 recites all the structure of claim 17 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

23. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of copending Application No. 10/760,252.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 18 of Application No. 10/760,252 recites all the structure of claim 1 of the present application. *It is noted that claim 18 of 10/760,252 currently depends from claim 16, however, this appears to be an error since "the slitter means" has no antecedent basis. It is believed that*

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claim 18 was intended to depend from claim 17, and this rejection is interpreting the claim to depend in that manner.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

24. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/760,237.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of Application No. 10/760,237 recites all the structure of claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

25. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of copending Application No. 10/760,220.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 16 of Application No. 10/760,220 recites all the structure of claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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26. Claim 17 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/760,220.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of Application No. 10/760,220 recites all the structure of claim 17 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

27. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 10/760,219.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of Application No. 10/760,219 recites all the structure of claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

28. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/760,213.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 14 of Application No. 10/760,213 recites all the structure of claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

29. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/760,180.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of Application No. 10/760,180 recites all the structure of claim 1 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

30. Claim 17 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of copending Application No. 10/760,180.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 18 of Application No. 10/760,180 recites all the structure of claim 17 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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31. Claim 15 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,002,664 in view of Ishii et al. (JP 2003-54044).

Claim 1 of U.S. Patent No. 7,002,664 discloses the claimed photofinishing system except for the drier means. Ishii et al. teaches a printer with a drier means including a blower 50 and guide rollers 82 and 84 as shown in Figure 2 of Ishii et al. It would have been obvious to combine the teaching of Ishii et al. with the photofinishing system recited by Claim 1 of U.S. Patent No. 7,002,664 for the advantage of quickly drying the printed photos.

32. Claims 25-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,002,664.

With respect to claims 25-26, claim 1 of U.S. Patent No. 7,002,664 recites all the structure in the claim except for the exact print media feed rate, print head assembly width and number or head chips. However, the optimal numbers for these characteristics is an obvious matter that could have been readily been determined by one of ordinary skill in the art through routine experimentation.

Allowable Subject Matter

33. Claims 1-26 would be allowed if terminal disclaimers are filed to overcome the above mentioned double patenting rejections.

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34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 18, 2006


Daniel J. Colilla
Primary Examiner
Art Unit 2854